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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,005	10/26/2001	Jean-Denis Dube	01393-P0053A	7854

24126 7590 02/24/2004

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EXAMINER

KOHNER, MATTHEW J

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/033,005

Applicant(s)

DUBE ET AL.

Examiner

Matthew J Kohner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-9, 11-13 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 3-5, 10, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date g.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Claim 2 has been cancelled and claims 1, 5, 11 and 15-18 amended.

Applicant states that the subject matter of claim 2 was incorporated into claim 1 (see applicant's response to office action, page 14). This is inaccurate. In fact, the language incorporated into claim 1 was missing 12 words from the first paragraph of claim 2. Specifically, the language about the hopper which recited that the hopper was positioned, "... extending longitudinally thereon between the first screener and the second screener" has been taken out of the claim language.

It was misleading for the applicant to state, "[c]aim 1 has been limited by the incorporation of the subject matter of claim 2...", but, in actuality, only incorporate some of the language of claim 2.

Applicant argues that the amendment to claim 16 makes it allowable for reasons similar to claim 2. However, claim 16 is not similar to claim 2, and in fact, is much broader than claim 2. For example, claim 16 is a method claim which doesn't even require that the screener be mobile.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7-9, 11-13 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,234,564 to Smith.

Smith discloses a mobile screening unit (See Fig. 1) for screening bulk material wherein the unit comprises:

- an elongated mobile support frame (See Fig. 1) having a longitudinal axis;
- a first screener (Col. 6, lines 18+) mounted to the support frame and extending longitudinally thereon, the first screener having:
  - an inlet (Col. 6, lines 18+) for receiving bulk material containing large sized, medium sized and small sized particles,
  - a first outlet (Col. 16, lines 18+) for releasing large sized particles, and
  - a second outlet (Col. 6, lines 18+) for releasing medium-sized and small sized particles, the first screener being used for screening the bulk material along a first direction substantially parallel to the longitudinal axis of the support frame (See Fig. 1); and
- a second screener (Col. 6, lines 18+) mounted to the support frame and extending longitudinally thereon, the second screener having:
  - an inlet (Col. 6, lines 18+) for receiving medium-sized and small-sized particles conveyed from the first screener,
  - a first outlet for releasing medium-sized particles (Col. 6, lines 18+), and
  - a second outlet for releasing small-sized particles (Col. 6, lines 18+), the second screener being used for screening the medium-sized particles from the small sized particles along a second direction substantially parallel to the longitudinal axis of the support frame (See Fig. 1).

- a feeding hopper (30) mounted to the support frame for accumulating bulk material, the feeding hopper having an inlet for receiving bulk material and an outlet for releasing bulk material; and

- a feeding conveyor (26) positioned to receive the bulk material released from the outlet of the feeding hopper and convey the same in the first direction to the inlet of the first screener.

In regard to claims 7-9, Smith discloses vibrating screens (Col. 4, line 4+).

In regard to claim 11, Smith discloses retractable rear and lateral side panels (Col. 2, line 62 – Col. 3, line 9).

In regard to claim 12, Smith discloses a hitch (16) and wheels (14).

In regard to claim 13, Smith discloses hydraulic support legs (Col. 5, lines 27+).

In regard to claims 16-18, Smith discloses a method screening bulk material, wherein the method includes the steps of:

- a) accumulating into a feeding hopper (30) bulk material containing large-sized, medium-sized and small-sized particles;

- b) receiving the bulk material from the feeding hopper;

- c) screening large-sized particles from medium-sized and small-sized particles along a first longitudinal direction screener (Col. 6, lines 18+);

- d) receiving medium-sized and small-sized particles obtained in step (c) (Col. 6, lines 18+); and

- e) screening medium-sized particles from small-sized particles along a second longitudinal direction substantially parallel to the first longitudinal direction screener (Col. 6,

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lines 18+). Further, in regard to claims 17 and 18, all the screening and conveying of materials is done in a direction substantially parallel to a longitudinal direction (See Fig 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith.

In regard to claim 6, Smith discloses a conveyor for receiving the medium-sized particles from the first outlet of the second screener wherein the piling conveyor is movable between a folded position, where it is folded against the rear end of the support frame, and an extended position. However, Smith's extended position is not along the same line as the support frame, rather it is perpendicular to the support frame. This is done because the large particles from the screening process are discharged in the rear along the same line as the support frame. It appears to be merely a matter of design choice to have the large particles discharged in line with the support frame and the medium particles discharged to the side. Further, it is well known in the art to have folded conveyors which extend along the same line as the support frame (see e.g. US Patent No. 5,819,950 to McCloskey). It would be obvious to one of ordinary skill in the art modify Smith's mobile screener so as to have the medium particles discharged in line with the support frame.

***Allowable Subject Matter***

Claims 3-5, 10, 14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kohner whose telephone number is 703-305-8496. The examiner can normally be reached on Mon-Fri 9-5:30.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Matthew J. Kohner  
Examiner  
Art Unit 3653

MJK

  
DONALD P. WALSH  
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